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REMARKS

I. Specification Objections

The Examiner objected to the specification because of the following informalities:

In paragraph [030], the Examiner stated that a reference to FIG. 6 is more appropriate. The Applicant notes that paragraph [030] has been amended to change the reference to FIG. 6.

In paragraph [034], lines 7-8, the Examiner stated that the statement within the parenthesis is interpreted as not being relevant to how to make or use the invention. The Applicant notes that paragraph [034] has been amended to remove the statement.

The Applicant further notes that paragraphs [004], [009], [014], [016], [023], [025], [026], [027] and [031] have been amended for typographical errors. The Applicant submits that no new matter has been added with these amendments.

II. Drawing Changes (replacement sheets)

The Applicant is submitting replacement sheets for FIGS. 3-6 to correct missing or incorrect reference item numerals. A marked up copy of originally submitted drawings sheets is also included to indicate the changes being made.

FIG. 3 has been amended to change reference item "150" to "140" in disclosing internal network 140 at the remote enterprise 150.

FIGS. 4-6 have been amended to include the reference numerals of the disclosed flow diagrams 400, 500 and 600.

The Applicant submits that no new matter has been added with these amendments.

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III. Claim Objections

The Examiner objected to claims 1 and 17 because of the following informalities: The Examiner interpreted claims 1 and 17 as "method" claims and recommends that claims 1 and 17 be amended to read in line 1 "A method of coordinating troubleshooting information".

The Examiner objected to claims 20-24 because of the following informality: Claims 20-24 are interpreted as "machine" claims. The Examiner recommended that claims 20-24, line 1, "The invention of claim 19" is amended to read "The machine of claim 19".

The Examiner objected to claims 3, 10, 12, 14 and 16 because of the following informality: The Examiner stated that line 1 reads "troubleshooting information" and should read "troubleshooting-related information" to remain consistent with dependent claim terminology.

The Examiner objected to claim 17 because of the following informality: The Examiner stated that in line 5, the statement "providing correcting malfunctions" is confusing and correction is required. The Applicant notes that claim 17 has been amended in response to this objection.

The Examiner objected to claim 23 because of the following informality: The Examiner stated that in line 1, "devices" is interpreted as being possessive and recommends that it be amended to "device's".

The Applicant notes that claims 1-24 have been canceled with this amendment thus rendering moot any objections that the Examiner had to these claims.

IV. Claim Rejections - 35 U.S.C. §112

The Examiner rejected claims 23 and 24 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

The Examiner stated that claims 23 and 24 recite the limitation "the device's internal software" in line 1. The Examiner stated that there is insufficient antecedent basis for this limitation in the claims.

The Examiner stated that claim 24 recites the limitation "additional data collection" in line 2 and that there is insufficient antecedent basis for this limitation in the claim.

The Applicant notes that claims 1-24 have been canceled with this amendment thus rendering moot any 35 U.S.C. §112 rejections that the Examiner had of these claims.

V. Claim Rejections - 35 U.S.C. §102

Requirements for Prima Facie Anticipation

A general definition of *prima facie* unpatentability is provided at 37 C.F.R.

§1.56(b)(2)(II):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v.*

United States, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, the reference cited by the Examiner must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, show that the reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

Carpenter

The Examiner rejected claims 17 and 18 under 35 U.S.C. §102(b) as being anticipated by Carpenter et al (U.S. Patent No. 6,260,048), hereinafter referred to as "Carpenter".

Regarding claim 17, the Examiner argued that Carpenter discloses coordinating troubleshooting of a remote machine, comprising the steps of:

a customer support enterprise receiving over a data network troubleshooting data from a remote machine, said troubleshooting data needed for analysis and providing correcting malfunctions of a machine within a support enterprise (citing FIG. 1, col. 4, lines 30-36; where vendor environment 100 is interpreted by the Examiner as a customer support enterprise and client environment 101 is interpreted by the Examiner as a remote malfunctioning machine);

automatically processing the troubleshooting data by enterprise equipment at the customer support enterprise (citing col. 3, lines 57-63; where the troubleshooting data is interpreted by the Examiner as being on a trouble ticket); and the customer support enterprise proceeding with at least one of:

i) electronically interacting with a customer using the troubleshooting data provided by the remote malfunctioning machine as a basis for the customer interaction, and providing the customer with corrective action based on troubleshooting data provided by the remote malfunctioning machine and the customer interaction (citing col. 1, lines 33-50 and col. 3, line 52-col. 4, line 22);

ii) providing corrective action over the data network directly to the remote malfunctioning machine after automatic analysis of the troubleshooting data (citing col. 4, lines 53-56) ; and

iii) escalating customer support to advanced support and providing advanced support utilizing at least one of the troubleshooting data, the analysis of the troubleshooting data, and customer interaction (citing col. 3, lines 56-63).

Regarding claim 18, the Examiner argued that Carpenter discloses the troubleshooting information is formatted in an object description interface prior to it being provided over the data network to the remote support enterprise (citing col. 4, lines 47-52; where the trouble ticket is interpreted by the Examiner as being formatted in an object description language).

The Applicant notes that claims 17 and 18 have been canceled with this amendment thus rendering moot any 35 U.S.C. §102(b) arguments that the Examiner had of these claims.

VI. Claim Rejections – 35 U.S.C. § 103

Requirements for Prima Facie Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. §2143 sets out the three basic criteria that a patent examiner must satisfy to establish a *prima facie* case of obviousness:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection), an applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443 (Fed. Cir. 1992). Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that each of the three aforementioned basic criteria has been met.

Sesek in view of Carpenter

The Examiner rejected claims 1-9, 11, 13, 15 and 19-24 under 35 U.S.C. §103(a) as being unpatentable over Sesek et al (U.S. Patent Publication No. 2005/0097405), hereinafter referred to as "Sesek", in view of Carpenter.

Regarding claim 1, the Examiner argued that Sesek teaches coordinating troubleshooting information associated with a machine, comprising the steps of:

maintaining troubleshooting-related information associated with functions of the machine within a system associated with the machine (citing paragraph [0036]); and

providing troubleshooting-related information over a data network to a remote support enterprise for fault analysis and utilization during customer interaction (citing paragraph [0039]).

The Examiner admitted that Sesek fails to teach a database. The Examiner argued that Carpenter teaches a database with troubleshooting related information (citing FIG. 1, item 23 and col. 4, lines 30-56).

The Examiner argued that it would have been obvious to a person skilled in the art at the time the invention was made to have included the database as taught by Carpenter in the invention of Sesek. The Examiner argued that it would have been obvious because the invention of Carpenter can be used for coordinating troubleshooting information in a printer environment (citing col. 2, lines 58-63 and col. 5, lines 40-50) such as taught by Sesek.

Regarding claims 2, 9, 11, 13 and 15, the Examiner argued that Sesek teaches the troubleshooting-related information includes at least one of: machine identity, machine location, error codes, machine usage history and customer identification (citing paragraph [0036]).

Regarding claim 3, the Examiner argued that Sesek teaches the troubleshooting information is formatted in an object description interface prior to being provided over the network to the remote support enterprise (citing paragraph [0038]).

Regarding claim 4, the Examiner argued that Sesek teaches the troubleshooting-related information is received by a remote support enterprise over the data network (citing paragraph [0039], support computing device 106); and the

troubleshooting-related information is automatically processed by the remote enterprise (citing paragraphs [0039] and [0047]).

Regarding claim 5, the Examiner argued that Sesek and Carpenter teach the troubleshooting-related information is received by a remote support enterprise over the data network (citing paragraph [0039], support computing device 106); the troubleshooting-related information is automatically processed by the remote support enterprise (citing paragraphs [0039] and [0047]); communication is provided by the remote enterprise with a customer associated with the machine (citing paragraphs [0040] and [0047]); and corrective data is developed by the remote support enterprise (citing Sesek paragraph [0047], where action to remedy the problem is interpreted as "corrective data"; and Carpenter, col. 4, lines 53-56, where the update is interpreted as corrective data).

Regarding claim 6-8, the Examiner argued that Carpenter teaches corrective data is received by the machine from the remote support enterprise over the data network (citing col. 4, lines 53-56, where the update is interpreted as "corrective data"); the corrective data is automatically processed by the machine (citing col. 4, lines 53-56); and the database of troubleshooting-related information associated with ongoing functions of the machine is maintained (citing col. 4, lines 53-56).

Regarding claim 19, the Examiner argued that Sesek teaches a machine (citing FIG. 2); a microprocessor (citing FIG. 2, paragraph [0022]); data communications equipment (citing FIG. 2, paragraph [0022]); an analysis module (citing FIG. 2, paragraph [0022]); a system adapted to develop a document containing data useful for remote troubleshooting of the machine (citing FIG. 2, paragraph [0027] and [0038]); a user interface (citing FIG. 2, paragraph [0025]); and wherein a document is developed with input and assistance of the previously identified elements that are organic to the machine, the document formatted for

transmission over the data network using the communication equipment (citing paragraphs [0038] and [0039]).

The Examiner admitted that Sesek fails to teach a database. The Examiner argued that Carpenter teaches a database with troubleshooting-related information (citing FIG. 1, item 23; col.4, lines 30-56). The Examiner argued that it would have been obvious to a person skilled in the art at the time the invention was made to have included the database as taught by Carpenter in the invention of Sesek. The Examiner stated that this would have been obvious because the invention of Carpenter can be used for coordinating troubleshooting information in a printer environment (citing col. 2, lines 58-63 and col. 5, lines 40-50) such as that taught by Sesek.

Regarding claims 20-22, the Examiner argued that Sesek teaches a photocopier, a printer and other marking devices (citing paragraph [0018]).

Regarding claim 23, the Examiner argued that Carpenter teaches the device's internal software is adapted causing corrective measures to be automatically executed on the machine in response to data received from a remote enterprise (citing col. 4, lines 53-56).

Regarding claim 24, the Examiner argued that Carpenter teaches the device's internal software is adapted causing additional data collection to occur in response to data or software received from the remote enterprise (citing col. 4, lines 23-45; and col. 5, lines 1-13 and lines 40-50).

The Applicant notes that claims 1-24 have been canceled with this amendment thus rendering moot any 35 U.S.C. §103(a) arguments that the Examiner had of these claims.

The Applicant further notes that a 37 C.F.R. §1.131 declaration of prior invention has been submitted with this amendment. This §1.131 declaration establishes a date of conception prior to the effective date of the filing of the Sesek

reference of November 3, 2003, thereby removing the Sesek reference as a valid 35 U.S. §103(a) prior art reference.

Sesek in view of Carpenter/Pfeiffer

The Examiner rejected claims 10, 12, 14, and 16 under 35 U.S.C. 103(a) as being unpatentable over Sesek in view of Carpenter and further in view of Pfeiffer et al. (US Patent Publication No. 2004/0078722), hereinafter referred to as "Pfeiffer".

Regarding claims 10, 12, 14 and 16, the Examiner argued that the combined invention of Sesek and Carpenter teach providing troubleshooting information over a data network to a remote support enterprise. The Examiner admitted that the combined invention of Sesek and Carpenter fails to teach of formatting the troubleshooting information in XML. The Examiner argued that Pfeiffer teaches formatting in XML before sending to a support enterprise (citing the abstract, paragraph [007]).

The Examiner argued that it would have been obvious to a person skilled in the art at the time the invention was made to have included the XML formatting as taught by Pfeiffer in the combined invention of Sesek and Carpenter. The Examiner argued that this would have been obvious because XML allows for a more comprehensive means of troubleshooting in a computer system (citing paragraphs [005]-[006] and [0016]).

The Applicant notes that claims 1-24 have been canceled with this amendment thus rendering moot any 35 U.S.C. §103(a) arguments that the Examiner had of these claims.

The Applicant notes that a 37 C.F.R. §1.131 declaration of prior invention has been submitted with this amendment. This §1.131 declaration establishes a date of conception prior to the effective date of the filing of the Pfeiffer reference of September 30, 2002, thereby removing the Pfeiffer reference as a valid 35 U.S. §103(a) prior art reference.

VII. Newly Presented Claims

The Applicant notes that new claims 25-48 have been presented with this amendment. The Applicant submits that claims 25-48 are not anticipated by any of the references cited by the Examiner.

Claim 25, the broadest of the three newly presented independent claims, is a method of automating customer assistance associated with a machine, comprising the steps of:

- collecting machine data in a database associated with said machine;
- creating a document containing said machine data;
- transmitting said document over a data network to a remote enterprise from said machine utilizing communication equipment associated with said machine;
- processing said document at said remote enterprise; and
- proceeding with one of the following while said remote enterprise is interacting telephonically with a customer:
 - i) providing said customer with corrective action for said machine;
 - ii) transmitting corrective action over said data network directly to said machine;
 - iii) escalating said fault analysis to an advanced customer support unit within said remote enterprise.

The Applicant submits, as explained above, that the Sesek and Pfeiffer references are not valid §103(a) references as the Applicant has submitted a 37 CFR §131 declaration showing that the applicant's date of conception is before the effective dates of the Sesek and Pfeiffer references coupled with due diligence.

Carpenter does not disclose all of the limitations of independent claim 25. For example, Carpenter does not disclose collecting machine data in a database associated with the machine. The Examiner argued that Carpenter discloses a database; however, in new claim 25, the machine data; i.e., machine identification, location, error codes, etc., is collected in the database. Carpenter discloses a database wherein the diagnostic knowledge trees are maintained within the database. The invention, as claimed, collects the machine data (machine identity, machine location, machine usage history, error codes, customer identification) with

information about the problem that the machine is experiencing. Carpenter does not disclose this limitation.

Additionally, independent claim 25 also claims transmitting corrective action over the data network directly to the machine. This step allows the remote enterprise (help desk) to remotely correct settings on the problem machine without user input. None of the cited references (Carpenter/Sesek/Pfeiffer) disclose this limitation. Carpenter teaches updating only the diagnostic knowledge tree, not actually transmitting the corrective action directly to the machine. As shown in Carpenter col. 4, lines 53-60:

"As described above, in vendor environment 100, when the vendor supplies an incident resolution of the incident set out in the trouble ticket, this can result in an update to diagnostic knowledge tree database 13. This update is communicated to diagnostic knowledge trees database 23 when the information in diagnostic knowledge trees database 13 is used to refresh diagnostic knowledge trees database 23." (emphasis added)

The Applicant submits that the cited references of Carpenter, Sesek and Pfeiffer do not disclose all of the disclosed limitations in the Applicant's independent claim 25. Therefore, the references of Carpenter, Sesek and Pfeiffer fail in the aforementioned prima facie anticipation and obviousness tests as all of the claimed limitations are not disclosed in any of the references singularly or in combination with the other references.

The Applicant notes that independent claim 36 and 45 include all of the claim limitations of claim 25, as discussed above, and include further limitations that are not anticipated by Carpenter, Sesek nor Pfeiffer. All claims dependent upon the independent claims 25, 36 and 45 are, of course, also not anticipated by the cited references as Carpenter, Sesek nor Pfeiffer disclose each and every claim limitation of claims 25-48. Therefore, the Applicant respectfully requests allowance of newly presented claims 25-48.

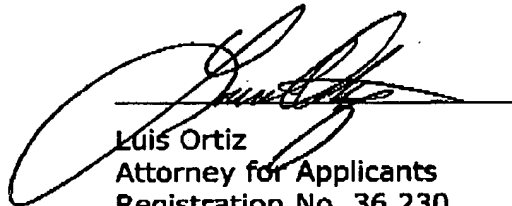
VIII. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §112, §102 and §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

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AMEND

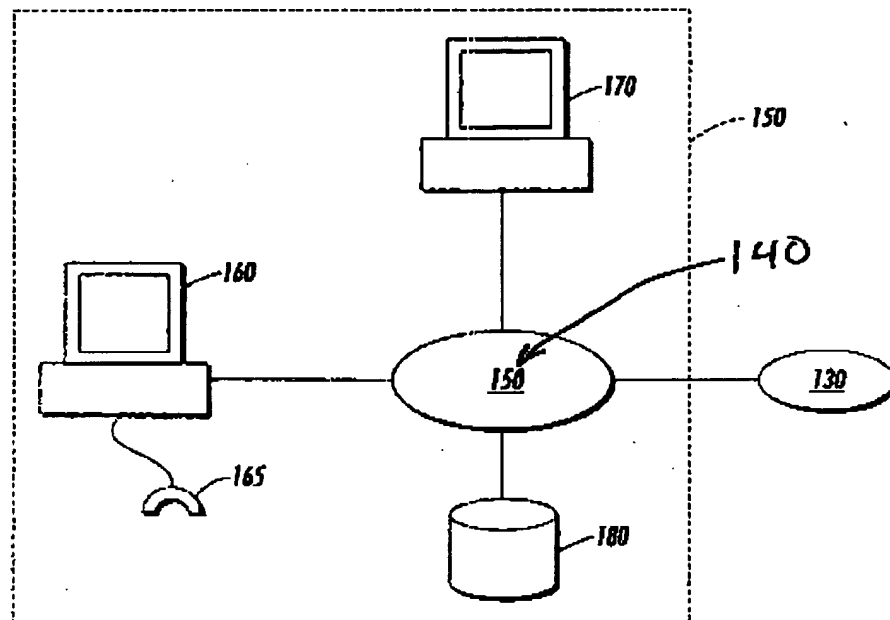


FIG. 3

Amended

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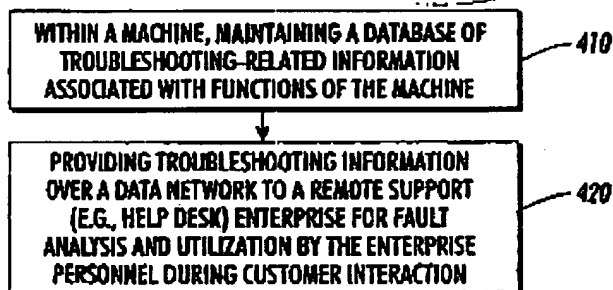


FIG. 4

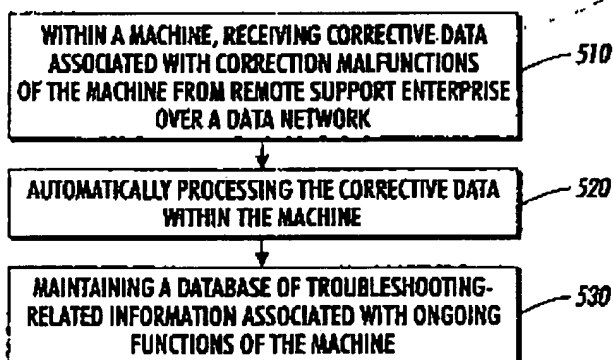


FIG. 5

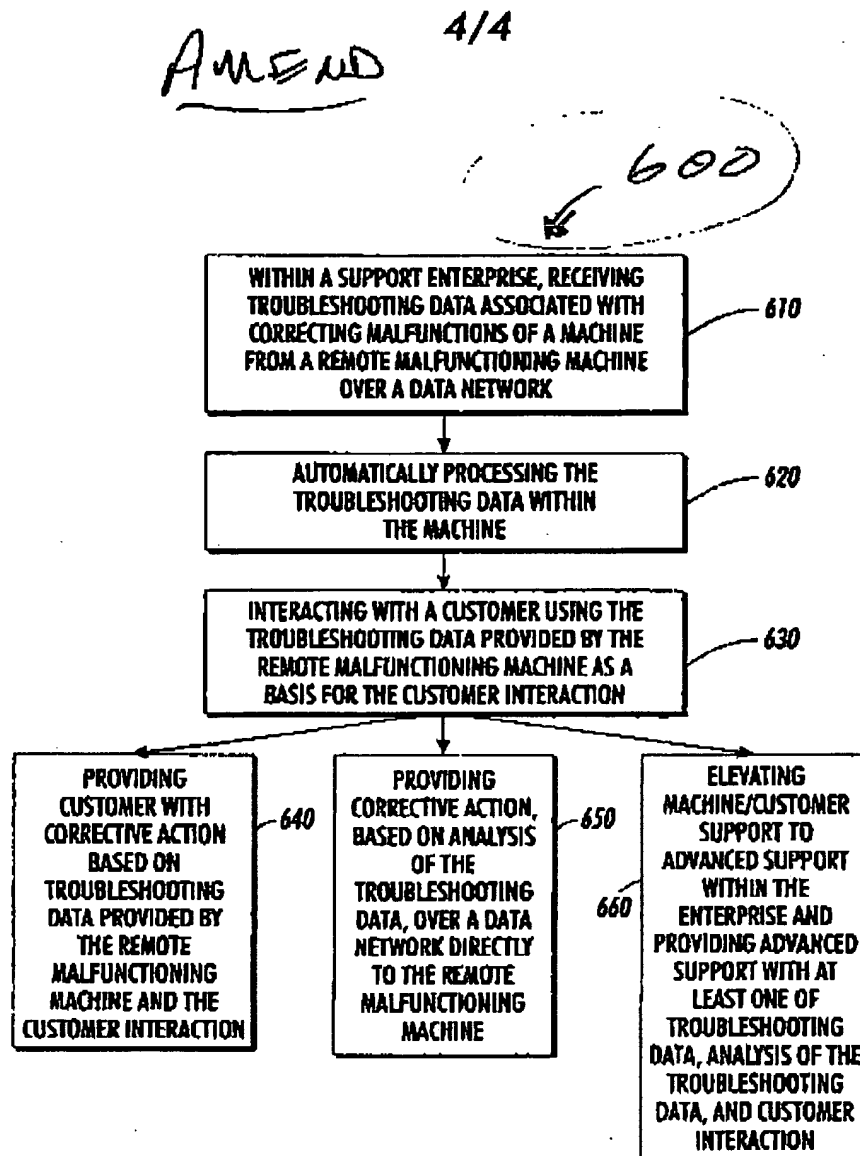


FIG. 6